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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,963	08/08/2001	Yoshinori Matsuura	981032A	2276

23850 7590 06/25/2003

ARMSTRONG, WESTERMAN & HATTORI, LLP  
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WASHINGTON, DC 20006

EXAMINER
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TSANG FOSTER, SUSY N

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 06/25/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-4

**Office Action Summary**

Application No.

09/923,963

Applicant(s)

MATSUURA ET AL.

Examiner

Susy N Tsang-Foster

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-7 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) 9-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 09/141,140.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 4-7, drawn to a metal hydride alkaline storage cell, classified in class 429, subclass 218.2.
  - II. Claims 9-17, drawn to a method of manufacturing a metal hydride alkaline storage cell, classified in class 29, subclass 623.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a different method such as using metal sulfate as the metal compound which is soluble in an electrolyte of a metal hydride alkaline storage cell to produce a negative electrode comprising hydrogen absorbing alloy powder having a layer of hydrogen absorbing alloy oxide formed on the surface thereof and having a catalytic metal dotted on the layer of the hydrogen absorbing alloy oxide in a granular state.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1745

4. During a telephone conversation with Daniel Geselowitz on 6/19/2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 4-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Response to Preliminary amendment***

6. This Office Action is responsive to the preliminary amendment filed on 8/8/2001. Claims 1-3, and 8 have been cancelled. Claims 4-7 and 11 have been amended. Claims 4-7 and 9-17 are pending. Claims 9-17 are withdrawn from further consideration as being drawn to a non-elected invention. Claims 4-7 are rejected for reasons given below.

***Priority***

7. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/141,140, filed on 8/27/1998.

Art Unit: 1745

8. It is noted that a certified translation of the foreign priority has been made in the parent case 09/141,140 in accordance with 37 CFR 1.55 which removes JP 10-134806 as an effective reference. See MPEP § 201.15.

***Information Disclosure Statement***

9. The information disclosure statement filed on 8/8/2001 has been considered by the Examiner.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 4-6, the limitation “a substrate which is soluble in the electrolyte; said substrate being selected from the group consisting of a metal fluoride, a metal chloride, a metal iodide, and a metal sulfide” is indefinite because it is unclear why the metal compounds are being referred to as substrates. It appears applicants intend to claim “substance” instead of “substrate”.

According to Merriam Webster's Collegiate Dictionary (Tenth Edition, Merriam-Webster, Incorporated, Springfield, 1997) a substrate is defined as “a substratum” and a substratum is defined as “an underlying support”. The metal compounds were not disclosed as substrates in the original disclosure.

Claim 7 depending from claim 6 is also rejected for the same.

Furthermore, in claims 4-7, the limitation "a catalytic metal or metal compound is dotted on said layer of hydrogen-absorbing alloy oxide in a granular state by adding a substance which is soluble in the electrolyte" is indefinite because it is unclear how a substance as the metal compound that is soluble in the electrolyte would dot the layer of hydrogen-absorbing alloy oxide in a granular state. Furthermore, it is unclear how two different results, that of the alloy oxide being coated by a catalytic metal and that of the alloy oxide being coated by the metal compound can be effected by the same process disclosed. A catalytic metal appears to be either nickel, aluminum, cobalt and copper in light of the specification.

### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 4-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,322,925 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Art Unit: 1745

claims 1 and 4 of U.S. Patent No. 6,322,925 B1 disclose common subject matter with instant claims 4-7 and anticipate instant claims 4-7.

### ***Conclusion***

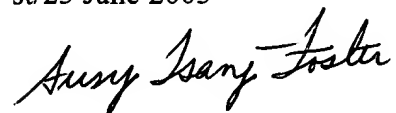
Any inquiry concerning this communication or earlier communications should be directed to examiner Susy Tsang-Foster, Ph.D. whose telephone number is (703) 305-0588. The examiner can normally be reached on Monday through Thursday from 9:30 AM to 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached at (703) 308-2383. The phone number for the organization where this application or proceeding is assigned is (703) 305-5900.

The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9310 for regular communications and (703) 872-9311 for After-Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

st/23 June 2003

A handwritten signature in cursive script, reading "Susy Tsang-Foster". The signature is written in dark ink and is positioned below the date line.